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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 17

Application Number: 09/551,706

Filing Date: April 18, 2000

Appellant(s): F. Ubel et al.

Matthew W. Adams

For Appellant

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EXAMINER'S ANSWER

This is in response to the appeal brief filed May 9, 2002.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

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(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1, 2, 4-23, 25-32, 38-46, 61 and 62 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,076,424	Nakamura	12-1991
5,003,970	Parker et al	4-1991
4,704,518	Ausnit	10-1987

International Patent WO 96/20884 to Cernohous, published July 11, 1996.

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(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Nakamura and also by International Patent WO 96/20884 to Cernohous. Nakamura teaches an apparatus comprising a pouch 10 with two ends, a length, and an interior, and a moisture sensitive product 3 having a continuous length, the product 3 being folded into a configuration comprising a plurality of sections in the interior and along the pouch length, each section comprising two folds and a segment spanning therebetween, the segment also extending along the pouch length. See Fig 13. Note that the product 3 is may be defined as "moisture sensitive" in the broadest sense of the word; the moisture content of the product 3 directly affects its function and usability. Also note that a given segment of the product 3 as it is shown in Fig 13 will extend to some degree along the pouch length. Cernohous teaches an apparatus comprising a pouch 10 with two ends and an interior, and a moisture sensitive product 22 having a continuous length, the product 22 being folded into a configuration comprising a plurality of sections in the interior along the length, each section comprising two folds and a segment spanning therebetween, the segment also extending along the pouch length. See Fig 1.

Claims 2, 5-9, 13-15, 17-20 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by

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Nakamura. Nakamura clearly teaches claims 2, 5, 7, 14, 15 and 17-20 in Fig 13. Regarding claim 6, the pouch is defined as being impervious in the Abstract. Regarding claim 8, item 14 may function as a compression device. Regarding claim 9, item 14 is located on the exterior of the pouch. Regarding claim 13, item 14 will also function as a sealing device. Regarding claim 22, see item 19.

Claims 1, 2, 4-10, 12-16, 25-28, 32, 38-46, 61 and 62 are rejected under 35 U.S.C. 102(b) as being anticipated by Parker et al, US Patent No. 5,003,970. Regarding claim 1, Parker teaches an apparatus 30 comprising a pouch 31 with two ends, a length and an interior, and a moisture sensitive product 14 having a continuous length (the roll), and being folded into a packaged configuration (Fig 14) comprising a plurality of sections (the layers seen in Fig 13) arranged within the interior and along the pouch length (seen in Fig 13), each section comprising two folds (at the edges) and a spanning segment (the middle portion of a layer) which extends along the pouch length. See Figs 8 and 13. Claims 2 and 4-10 are clearly met by Parker. Regarding claim 2, Parker's pouch 31 comprises an opening 33 proximate the first end, which clearly permits access to the interior of the pouch. Regarding claim 4, see the last five lines of the Abstract of Parker. Regarding claim 5, see Fig 13, where the layers of the product appear to be identical. Regarding claim 6, see the first line of the Abstract of Parker, where the pouch 31 of Parker is taught to be moisture-impervious. Regarding claim 7, it appears to be clear from Fig 14, that the product length will be at least two times the pouch length. Item 36 meets all of the limitations claimed in claims 8-10; item 36 is a compression device proximate the opening 33, which is located on the exterior of the pouch, and it comprises two opposing compressible members biased towards one another. Regarding claim 12, item 36 will clearly conform the shape of the pouch to the shape of the product. Regarding claim 13, item 36 functions as a sealing device. Regarding claim 14, see Fig 15 where the pouch width appears to be substantially constant

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along the length, from the end at 33 to the other end. Regarding claim 15, see Fig 13, where a cross section of the product has two folds and a segment in between. Regarding claim 16, the cross section of the product 14 shown in Fig 13, shows an elongated “S” shape. Regarding claim 25, Parker teaches an apparatus 10 comprising a pouch 32 comprising an interior, and a compression device 36 which couples to the pouch first end, and has two opposing members, and which will shape the end of the pouch to the shape of the product. See Fig 11 or 15. Claims 26-28 and 38-41 are clearly met by Parker, as are claims 44-46. Regarding claim 26, Parker’s pouch 31 comprises an opening 33 proximate the first end, which clearly permits access to the interior of the pouch. Regarding claim 27, the sealing device 36 of Parker will substantially seal the opening 33. Regarding claim 28, the flat portions of item 36 form a parallel closure device. Regarding claim 32, the compression members (opposing flat portions) of item 36 of Parker will conform the shape of the end of the pouch to the shape of the product. Regarding claim 38 and 39, see the last five lines of the Abstract of Parker. Regarding claim 40, the first and second compression members of item 36 are biased towards one another and at least one is compressible. Regarding claim 41, Parker’s pouch 31 is elongated and the compression device 36 is selectively movable along the length. Regarding claim 42, Parker teaches a closure apparatus 36 comprising a compression device comprising two opposing compression members (the two curved arms of the device), and a sealing device coupled to the compression device, comprising opposed sealing members (the flat pressing sections of the device) wherein the sealing members are movable between open and closed positions. Regarding claim 43, the semi-circular portion of the device 36 is a frame assembly which couples the compression and sealing devices together. Regarding claim 44, the pouch 31 has a first end and an opening 33, the closure apparatus 36 securable proximate the first end. Regarding claim 45, the compression members of item 36 will shape the pouch to the shape of the product. Regarding

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claim 46, the sealing device 36 will seal the opening of the pouch. Regarding claim 61, Parker teaches an apparatus 30 comprising a pouch 31 with two ends, a length and an interior, and a moisture-curable orthopedic splinting/casting product 14 having a continuous length (the roll), and being folded into a packaged configuration (Fig 14) comprising a plurality of sections (the layers seen cross-wise in Fig 13) arranged within the interior and along the pouch length (seen in Fig 13), each section comprising two folds (at the edges) and a spanning segment (the middle portion of a layer) which extends along the pouch length. Regarding claim 62, Parker teaches an apparatus 30 for storing and dispensing a continuous length of moisture sensitive product 14, the apparatus comprising: a pouch 31 with an interior and a first end, and a compression device 36 comprising first and second opposing compressible members (the flat portions of item 36) which will shape the first end of the pouch to the shape of the product.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura. It would have been obvious to one of ordinary skill in the art at the time the invention was made to move the suspension member 19 of Nakamura to either end of the pouch 10 for the purpose of better suiting the dispensing process to a given position or orientation.

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parker in view of Ausnit. Parker teaches all the limitations of claim 29 except the female member receiving the male member so that

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the pouch is trapped between. Ausnit teaches a pouch locking system which has male and female members and which lock a pouch between the two. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the male/female sealing device into that of Parker in order to produce a tighter seal.

Claims 11, 21, 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parker. Regarding claim 11, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate foam padding into the compression members of item 36 in order to prevent damaging the pouch 32. Regarding claims 21, 30 and 31, it would have been obvious to one of ordinary skill to attach a suspension member to an end of the pouch in order to hang the pouch for dispensing.

(11) Response to Arguments

I - Whether Claim 1 is anticipated under 102(b) by Nakamura

Regarding the remarks on pages 6 and 7, Examiner maintains that the term “moisture-sensitive” has been given a broad but reasonable interpretation, and that within that interpretation the product 3 of Nakamura is in fact “moisture-sensitive.” Loss of moisture by this product will affect its ability to perform its intended function. Applicant gives the term “moisture sensitive” a narrower definition in his arguments than the one he employs in the Specification. The term “moisture sensitive” *alone* does not necessarily have to be interpreted as a synthetic splinting material. The Specification does not define “moisture sensitive” as being a synthetic splinting material.

Contrary to the remarks at the top of page 8, there is no claim language in claim 1 that requires a segment *parallel* to the pouch length. Applicant is reading limitations into the claims. It is maintained that Nakamura teaches a moisture sensitive product 3 having a continuous length, the product 3 being folded into

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a configuration comprising a plurality of sections (*1 section = four segments making a helical loop*) arranged within the interior and along the pouch length, each section comprising two folds and a segment spanning therebetween, the segment also extending along the pouch length. *A given section of the product 3 as it is shown in Fig 13 will extend, due to its helical arrangement, along the pouch length, and a given segment of a given section of the product 3 will also extend along the pouch length*, thus satisfying the limitations of the claim.

II - Whether Claim 1 is anticipated under 102(b) by Cernohous et al

It is maintained that Cernohous teaches a “moisture-sensitive” product, in the broadest sense of the term, as noted above. It is maintained that the thickness of the material extends along the pouch length and also spans the two folds, thus satisfying the claim limitations.

III - Whether Claims 2, 5-9, 13-15, 17-20 and 22 are anticipated under 102(b) by Nakamura

It is maintained that item 14 of Nakamura may function as a compression device and also as a sealing device.

IV - Whether Claims 1, 2, 4-10, 12-16, 25-28, 32, 38-46, and 61-62 are anticipated under 102(b) by Parker et al

It is maintained that, in Fig 13, Parker shows folds of material 14, with edges, and that the segments which span between these edges have a component along the length of the pouch, thus satisfying the limitations of the claims.

Regarding the remarks on pages 15 and 16, it is maintained that the compression device 36 of Parker is clearly adapted to conform the shape of the pouch to the shape of the product. It appears to be doing just that in Fig 11. Furthermore, were product being dispensed from Parker’s pouch, *compression member 36*

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could be utilized in such a way so as to conform the product to the pouch, as required by claim 32. It is maintained that Parker teaches the limitations of the claims, as noted in the final rejection.

Regarding the remarks at the bottom of page 18, it is maintained that the two flat portions of item 36 of Parker will function as compression members, and that item itself will function as a “compression device.”

V - Whether Claim 23 is anticipated under 103(a) by Nakamura

It is maintained that it would have been obvious to one of ordinary skill in the art at the time the invention was made to move the suspension device 19 of Nakamura to another end of the pouch, as noted in the rejection.

VI - Whether claim 29 is anticipated under 103(a) by Parker et al in view of Ausnit

It is maintained that the Ausnit reference suggests obvious and proper modification to the Parker reference, as noted in the final rejection.

VII - Whether Claims 11, 21, and 30-31 are anticipated under 103(a) by Parker et al

It is maintained that it would have been obvious to one of ordinary skill in the art to modify the compression device 36 of Parker with foam padding to protect the pouch when the compression device is in use. Regarding claim 21, multiple sections of item 14 of Parker will form a “mushroom shape,” as required by claim 21.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Troy Arnold



TGA

May 30, 2002

Conferees



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